

### REMARKS

Applicants' representative thanks the Examiner for the courtesies extended during the telephonic conference on June 19, 2008, with Francis Dunn. During the telephonic conference, there was discussion regarding the rejection of the subject claims under 35 U.S.C. § 101. There was discussion regarding the rejection of the claims under 35 U.S.C. § 103 and the cited art, including Price *et al.* (US Pub. No. 2001/0043716) and Nagae (U.S. Pat. No. 6,230,169)). There was also discussion of a proposed amendment to independent claim 1, wherein it was indicated that the proposed amendment to independent claim 1 may overcome the rejection under 35 U.S.C. § 101.

Claims 1-20 are currently pending in the subject application and are presently under consideration. Claims 1, 14, and 20 have been amended as shown on pages 2-5 of the Reply. No new matter has been added, and the amendments to the claims made herein will not require a new search.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claims 1-20 Under 35 U.S.C. § 101**

Claims 1-20 stand rejected under 35 U.S.C. § 101 on the grounds that the claimed invention is directed to non-statutory subject matter. Withdrawal of this rejection is requested for at least the following reason. The subject claims are directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Independent claim 1 recites: *[a] system that facilitates free form digital inking, the system is recorded on a computer-readable medium and capable of execution by a computer, comprising: a processor; an annotation management component that generates a zoom window comprising an inking region for a digital document; and a navigation component that enables manual and automatic re-positioning and re-sizing of the zoom window and the inking region relative to the digital document, the re-positioning and re-sizing of the zoom window and the inking region occurs prior to, concurrently with, and after annotation of the digital document based at least in part on an amount of annotation information displayed in the inking region, the size of the zoom window corresponds to the size of the inking region.*

The claimed subject matter relates to a system that can facilitate free form digital inking,

wherein the *system is recorded on a computer-readable medium and capable of execution by a computer*. The claimed subject matter includes components, such as *a processor, an annotation management component* and *a navigation component*, which can facilitate free form digital inking associated with documents (e.g., digital documents). The claimed subject matter, comprising a processor, can facilitate free form digital inking, and can produce a useful, concrete, and tangible result. Thus, the claimed subject matter is directed to a tangible embodiment and is therefore in accordance with 35 U.S.C. § 101.

Further, independent claim 14 recites: A *computer-implemented method that provides a zoom window to annotate digital documents with digital ink*, comprising: generating the zoom window comprising an inking region; scaling contents displayed in the zoom window; enabling manual and automatic re-positioning and re-sizing of the zoom window relative to at least one digital document . . . ; positioning the zoom window over an area of interest; and navigating the zoom window after annotating the at least one digital document.

The claimed subject matter is a *computer-implemented method* that provides a zoom window to annotate digital documents. Further, the claimed subject matter can be implemented by a computer. The claimed subject matter is therefore directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Furthermore, for at least reasons similar to the reasons stated with regard to independent claim 1, independent claim 20 is directed to statutory subject matter in accordance with 35 U.S.C. § 101.

Thus, independent claims 1, 14 and 20 (and associated dependent claims) recite statutory subject matter as they can produce a useful, concrete, and tangible result such to be classified as patentable subject matter according to 35 U.S.C. § 101.

In view of at least the foregoing, it is readily apparent that the subject claims are directed to statutory subject matter in accordance with 35 U.S.C. § 101. Accordingly, withdrawal of this rejection is requested.

## **II. Rejection of Claims 1-2, 4-16, and 18-20 Under 35 U.S.C. § 103(a)**

Claims 1-2, 4-16, and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price *et al.* (US Pub. No. 2001/0043716) (hereinafter “Price *et al.*”) in view of Nagae (U.S. Pat. No. 6,230,169) (hereinafter “Nagae”). Withdrawal of this rejection is

respectfully requested for at least the following reason. Price *et al.* and Nagae, either alone or in combination, fail to disclose, teach, or suggest each and every element set forth in the subject claims. To reject claims under 35 U.S.C. § 103(a),

the prior art reference (or references when combined) ***must teach or suggest all the claim limitations***. See MPEP § 706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The claimed subject matter relates to systems and methods that can facilitate annotating digital documents (*e.g.*, word processing documents, images, *etc.*) displayed devices (*e.g.*, desktop computers, Tablet personal computers (PCs), personal digital assistants (PDAs), cellular phones, and the like). (See p. 3, lns. 13-16.) In one aspect, the claimed subject matter can provide a focus plus context-based interface that can enable multi-scale navigation during document annotation. (See p. 7, lns. 5-6.) The interface can zoom a region of an underlying document, wherein a user can enter annotations in the region at a size comfortable to the user and suitably scaled to the device display. (See p. 3, lns. 16-19.)

In particular, independent claim 1 recites: *a navigation component that enables **manual and automatic re-positioning and re-sizing of the zoom window and the inking region relative to the digital document, the re-positioning and re-sizing of the zoom window and the inking region occurs prior to, concurrently with, and after annotation of the digital document based at least in part on an amount of annotation information displayed in the inking region, the size of the zoom window corresponds to the size of the inking region.*** Price *et al.* and Nagae, either alone or in combination, do not teach or suggest the distinctive aspect of the claimed subject matter.

Rather, Price *et al.* relates to a system and method that enables free-form digital ink annotation of data traces and storage management of the data trace based upon the free-form digital ink annotations. (See Abstract; p. 2, ¶ [0029].) Price *et al.*, teaches a system that can automatically select regions in the data trace based upon the position of the annotation and automatically summarize the data traces, and manage the storage of the data of a data trace based upon the freeform digital ink annotations. (See p. 2, ¶¶ [0028]-[0029].)

However, unlike the claimed subject matter, Price *et al.* fails to teach a zoom window let alone re-positioning and/or re-sizing a zoom window and an associated inking region prior to, concurrently with, and after annotation of the digital document based on the amount of annotation information displayed in the inking region, where the size of the zoom window corresponds to the size of the inking region. Instead, Price *et al.* teaches that a user may be provided with control over the scale of the display of a data trace so that the scale of the entire data trace may be adjusted so that the size of the corresponding portion of the data trace matches or approximates the size of the corresponding freeform digital ink annotation. (See Abstract; p. 2, ¶ [0033].) Thus, Price *et al.* simply teaches that the user can manually control the scale of the display of a data trace. Price *et al.* also fails to teach that re-positioning and/or re-sizing a zoom window and an inking region can occur concurrently with annotation of a digital document.

Further, Nagae fails to teach the distinctive features of the claimed subject matter as recited in independent claim 1. Rather, Nagae teaches an annotation display function that enables a user to check the contents of annotations while reading the text by reducing or enlarging the display image of an annotation input window with a specified magnification in displaying annotations and by superposing the displayed image in a specified position on the text display image on a text display screen. (See col. 1, lns. 42-49.) However, Nagae fails to teach re-positioning and/or re-sizing a zoom window and an inking region prior to, concurrently with, and after annotation of a document based on the amount of annotation information displayed in the region. Instead, Nagae teaches changing the display magnification of a display image of the annotation based on a specified magnification that can be a system-specified magnification (*e.g.*, default magnification) that can be prepared beforehand or a user-specified magnification. (See col. 2, lns. 21-37.) Nagae also teaches that an annotation input window that is of a fixed size when the user has opened the window on the screen, and the screen can be enlarged or reduced to the size determined by its bottom right end position and its top left end position, when the user moves the window's bottom right end with a pen. (See col. 6, ln.67 – col. 7, ln. 5.) Further, unlike the claimed subject matter, Nagae also fails to teach a zoom window that is sized in correspondence with the size of an inking region.

In contrast, the claimed subject matter can facilitate free form digital inking associated with digital documents, which can facilitate annotation of digital documents. (See p. 8, ln. 29 – p. 9, ln. 3.) In one aspect, the claimed subject matter can create a zoom window that can comprise

an inking region, which can be utilized to facilitate annotating the digital document. (See p. 17, ln. 29 – p. 18, ln. 1; p. 4, ln. 27 – p. 5, ln. 6; Fig. 11.) The claimed subject matter can ***re-position and re-size the zoom window and inking region*** associated with a digital document ***prior to, concurrently with, and after annotation of the digital document based at least in part on an amount of annotation information displayed in the inking region.*** (See p. 10, ln. 18 – p. 11, ln. 2.) Further, ***the size (e.g., re-size) of the zoom window corresponds to the size (e.g., re-size) of the inking region.*** (See p. 17, ln. 29 – p. 18, ln. 1; p. 4, ln. 27 – p. 5, ln. 6; Fig. 11.) Thus, for instance, if the inking region increases in size to accommodate additional annotation information, the zoom window can correspondingly increase in size to facilitate display of the annotation information.

For example, a user can enter annotation in an inking region contained within a zoom window. As the user enters annotation information in the inking region, the zoom window and inking region can be re-sized and/or re-positioned, as desired, based in part on the amount of annotation information being received and/or displayed in the inking region. (See p. 10, ln. 18 – p. 11, ln. 2.) Continuing with the example, if the zoom window, as currently sized, is full or close to becoming full (e.g., a portion of the annotation information is near the edge of the zoom window), the zoom window and inking region each can automatically increase in size (e.g., increase the size of the zoom window and create additional space in the inking region) and/or can be re-positioned to facilitate displaying additional annotation information as such information is received and displayed. (See p. 10, ln. 18 – p. 11, ln. 2; p. 17, ln. 29 – p. 18, ln. 1.) The change in size of the zoom window can correspond with the change in size of the inking region. (See p. 17, ln. 29 – p. 18, ln. 1; p. 4, ln. 27 – p. 5, ln. 6; Fig. 11.)

Further, independent claim 14 (and similarly independent claim 20), as amended, recites: ***generating the zoom window comprising an inking region; scaling contents displayed in the zoom window; enabling manual and automatic re-positioning and re-sizing of the zoom window and the inking region relative to at least one digital document, the re-positioning and re-sizing of the zoom window and the inking region occurs prior to, concurrently with, and after annotation of the at least one digital document as a function of an amount of annotation information displayed in the inking region, wherein size of the zoom window corresponds to size of the inking region.***

For at least reasons similar to the reasons stated with regard to independent claim 1, Price *et al.* and Nagae, either alone or in combination, do not disclose, teach, or suggest the distinctive aspects of the claimed subject matter. The cited art does not teach automatically re-positioning and re-sizing a zoom window and an inking region within the zoom window, relative to a digital document. Also, the cited art fails to teach that *re-positioning and re-sizing of the zoom window* occurs *prior to, concurrently with, and after annotation* of the digital document. Further, the cited art fails to teach that the size of the zoom window corresponds to the size of the inking region, such that when the inking region changes in size due to changes in the amount of annotation, the zoom window correspondingly changes in size to accommodate the change in size of the inking region and change in the amount of annotation.

In view of at least the foregoing, it is readily apparent that Price *et al.* and Nagae, either alone or in combination, fail to disclose, teach, or suggest each and every element of the claimed subject matter as recited in independent claims 1, 14, and 20 (and associated dependent claims 2, 4-13, 15, 16, 18, and 19). Accordingly, it is believed that the subject claims are in condition for allowance, and the rejection should be withdrawn.

### **III. Rejection of Claims 3 and 17 Under 35 U.S.C. § 103(a)**

Claims 3 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Price *et al.* in view of Nagae and N.O. Bouvin *et al.*, “Fluid Annotations Through Open Hypermedia: Using and Extending Emerging Web Standards”, Proceedings of the 11<sup>th</sup> international conference on World Wide Web, May 7-11, 2002, Honolulu, Hawaii, Pages 160-171 (hereinafter “Bouvin *et al.*”). Claim 3 depends from independent claim 1; and claim 17 depends from independent claim 14. Bouvin *et al.* fails to cure the aforementioned deficiencies of Price *et al.* and Nagae with regard to independent claims 1 and 14. Based at least on the foregoing reasons, withdrawal of the rejection is respectfully requested.

Further, claim 3 (and similarly claim 17) recites: the inking region is generated in connection with animation that makes it appear the inking region grows out of the digital document. Price *et al.* Nagae, and Bouvin *et al.*, either alone or in combination, fail to teach or suggest such distinctive feature of the claimed subject matter.

The Examiner states that Price *et al.* and Nagae fail to teach that the inking region is generated in connection with animation that makes it appear the inking region grows out of the

digital document. (See Office Action dated May 12, 2008, p. 23, lns. 11-13.) Further, Bouvin et al. fails to teach the distinctive feature of the claimed subject matter. Rather, Bouvin et al. teaches animated opening/closing and a “push down” technique that gradually reveals a gloss while lines below the gloss are pushed down to make room. However, unlike the claimed subject matter, Bouvin et al. fails to teach an inking region that appears to grow out of a digital document.

In view of at least the foregoing, it is readily apparent that Price *et al.*, Nagae, and Bouvin, *et al.*, either alone or in combination, fail to disclose, teach, or suggest each and every element of the claimed subject matter as recited in claims 3 and 17. Accordingly, it is believed that claims 3 and 17 are in condition for allowance, and it is respectfully requested that the rejection be withdrawn.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP592US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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